

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY E. TOYCEN, DARRYL L. ASPEY
and DARIN J. GOODWILER

Appeal No. 2004-0119
Application 08/644,170

ON BRIEF

Before ABRAMS, FRANKFORT, and STAAB, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1, 3 and 5 as amended subsequent to the final rejection in a paper filed October 21, 1998 (Paper No. 11). Claims 1, 3 and 5, are the only claims pending in the application. Claims 2 and 4 have been canceled.

Appellants' invention is directed to a hand operated, pliers-type crimping tool for blasting caps. Independent claim 1 is representative of the subject matter on appeal and reads as follows:

1. A pliers-type crimping tool for blasting caps, comprising a pair of pivotally connected jaws, each jaw having a pair of crimping elements formed integrally as part of the respective jaw and operative for forming a double crimp in a single jaw closing operation, said crimping tool composed of aluminum for providing non-sparking and non-magnetic properties, and wherein the outer surfaces of the aluminum are provided with a dense anodic coating to enhance wear properties, and wherein outer surfaces of the aluminum that are susceptible to wear are provided with an anodic coating having a thickness of at least 0.001 inch.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Mino et al. (Mino)	610,305	Sept. 6, 1898
Klingler	2,784,621	Mar. 12, 1957
Ogden	4,822,458	Apr. 18, 1989
Zelenka	5,560,269	Oct. 1, 1996

Claims 1, 3 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mino in view of Klingler, Zelenka and Ogden.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the

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conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the examiner's answer (Paper No. 12, mailed January 5, 1999) for the reasoning in support of the rejection, and to appellants' brief (Paper No. 11, filed October 21, 1998) and reply brief (Paper No. 13, filed March 8, 1999) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

The examiner's rejection of claims 1, 3 and 5 on appeal under 35 U.S.C. § 103(a) based on the collective teachings of Mino, Klingler, Zelenka and Ogden recognizes that the pliers-type crimping tool for blasting caps of Mino includes a pair of pivotally connected jaws (4, 5), with each jaw having an integral crimping element (9). The examiner notes (answer, page 4) that

Mino does not disclose a *pair* of crimping elements on each jaw and does not explicitly disclose the material of the tool. We observe that Mino also does not disclose a dense anodic coating like that set forth in claim 1 on appeal.

To account for the first of the above-noted differences, the examiner's looks to Klingler, urging that this patent teaches that it is known in the art to form a crimping tool with a plurality of crimping elements (30, 32, 34, 36; 38, 40, 42, 44), and concluding that it would have been obvious to one of ordinary skill in the art at the time appellants' invention was made to have modified the jaws of Mino by providing another crimping element on each jaw as taught by Klingler in order to form a plurality of crimps on a workpiece in a single operation of the tool. In this regard, the examiner further contends that mere duplication of the essential working parts of a device involves only routine skill in the art.

To address the second difference, the examiner turns to Zelenka, contending that this patent "teaches that it is known in the art to form a tool entirely of aluminum as set forth in column 5, line 66 to column 3, line 2" (answer, page 4). From

this teaching the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time appellants' invention was made to have further modified Mino by forming the tool of aluminum as taught by Zelenka in order to reduce the weight of the tool and to reduce the cost of manufacture. In this regard, the examiner further urges that

[i]t would have been obvious to one of ordinary skill in the art to have formed the tool of Mino et al. out of any preferred material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice (answer, page 4).

To account for the third difference noted above, the examiner has pointed to Ogden, urging that this patent teaches that it is known in the art to provide thick, anodic coatings on aluminum parts in order to protect against abrasion and corrosion and to provide a tough, electrically insulating coating. From this teaching, the examiner concludes (answer, pages 4-5) that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided an anodic coating on the modified tool of Mino as taught by Ogden in order to protect against abrasion and corrosion and to provide a tough, electrically insulating coating. With regard to the thickness of

the anodic coating specified in appellants' claims on appeal, the examiner notes that "Ogden discloses that an anodic coating of 30-40 micrometers (0.001 in -0.0015 in) thickness is preferred." The examiner also contends that it would have been obvious to one of ordinary skill in the art to have utilized any particular thickness of anodic coating since it has been held that where the general conditions of a claim are disclosed in the prior art discovering the optimum or workable ranges involves only routine skill in the art.

Appellants argue, and we strongly agree, that given the disparate nature of the various references applied by the examiner, one of ordinary skill in the art would have found no reason or suggestion to combine Mino with Klingler, Zelenka and Ogden in the particular manner urged by the examiner so as to arrive at appellants' pliers-type crimping tool as defined in the claims before us on appeal. More specifically, it is our view that even if it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to provide the crimping tool of Mino with a pair of crimping elements formed integrally on each jaw, based on teachings derived from Klingler, so as to allow the crimping tool therein to form a double crimp

in a single jaw closing operation, we see no teaching, suggestion or motivation in the remaining references applied by the examiner which would have led one of ordinary skill in the art to then consider forming the crimping tool of Mino from a relatively soft metal like aluminum, thereby creating a problem situation which would subsequently also require a dense anodic coating to be applied on the outer surfaces of the aluminum tool to enhance wear properties thereof. As urged by appellants in their brief and reply brief, none of the references applied by the examiner would have led one of ordinary skill in the art at the time of appellants' invention to make a tool with wear susceptible elements like those in the crimper of Mino out of aluminum. Instead, it appears that the prior art would have led the ordinarily skilled worker to use a known hard material, such as steel, for such a tool, or at least for the wear susceptible elements thereof.

In our view, the examiner's position in this appeal represents a clear case of impermissible hindsight reconstruction of the claimed invention based on appellants' own teachings. In that regard, we note, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed.

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Cir. 1992), that it is impermissible for the examiner to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

Since we have determined that the teachings and suggestions found in Mino, Klingler, Zelenka and Ogden would not have made the subject matter as a whole of independent claim 1 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of that claim under 35 U.S.C. § 103(a). It follows that the examiner's rejection of dependent claims 3 and 5 under 35 U.S.C. § 103(a) will likewise not be sustained.

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Accordingly, the decision of the examiner to reject claims 1, 3 and 5 of the present application under 35 U.S.C. § 103(a) is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
LAWRENCE J. STAAB)	
Administrative Patent Judge)	

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